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RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			HILLERY, NATHAN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHENG YE, WEI SUN, and ZHONG TIAN

Appeal 2009-014145
Application 10/689,186
Technology Center 2100

Before ROBERT E. NAPPI, GREGORY J. GONSALVES, and KALYAN K. DESHPANDE, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

The Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 23-42, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We REVERSE.

The Appellants invented method and apparatus for locating and transforming data in a data file. Specification 1:7-8.

An understanding of the invention can be derived from a reading of exemplary claim 23, which is reproduced below [bracketed matter and some paragraphing added]:

23. A method for generating at least a first output file from at least one input file, comprising the steps of:

- [1] defining at least one data unit of the at least one input file;
- [2] determining one or more locations within the at least one input file of the at least one data unit; and
- [3] transferring the at least one data unit from the one or more locations within the at least one input file to the one or more locations within the first output file specified by a mapping of the at least one data unit of the at least one input file to one or more locations within the first output file;
- [4] wherein each location comprises a horizontal position, the horizontal position comprising at least one of an uppermost position of the data unit or a lowermost position of the data unit, and a vertical position, the vertical position comprising at least one of the leftmost position of the data unit or the rightmost position of the data unit; and

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jan. 13, 2009) and Reply Brief ("Reply Br.," filed June 1, 2009), and the Examiner's Answer ("Ans.," mailed Apr. 1, 2009), and Final Rejection ("Final Rej.," mailed June 13, 2008).

[5] wherein each data unit is defined based on at least one of: at least one string, at least one absolute position of the data unit within the input file, at least one relative position of the data unit to a start or end of at least one of a row or column of the input file, and at least one relative position of the data unit to another data unit.

REFERENCE

The Examiner relies on the following prior art:

Barr, Michael, "Programming Embedded Systems in C and C++" 1-2 (O'Reilly, Jan. 1999).

REJECTIONS

Claims 23-42 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement.

Claims 23-42 stand rejected under 35 U.S.C §102(b) as being anticipated by Barr.

ISSUES

The issue of whether the Examiner erred in rejecting claims 23-42 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement turns on whether the Specification conveys to a person with ordinary skill in the art that the Appellants were in possession of the claimed invention and whether the Specification teaches a person with ordinary skill in the art how to make and use the full scope of the claimed invention without undue experimentation.

The issue of whether the Examiner erred in rejecting claims 23-42 under 35 U.S.C §102(b) as being anticipated by Barr turns on whether Barr describes limitation [4] of claim 23 and as recited in independent claims 30 and 37.

ANALYSIS

Claims 23-42 rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement

The Examiner found that claims 23-42 fail to comply with the written description and enablement requirements because the specifics for each of the claim limitations cannot be ascertained from the Specification. Ans. 3-4. The Appellants contend that the Specification complies with both the written description and enablement requirements and the Appellants specifically highlight where the Specification conveys and teaches the claim limitations at App. Br. 6-12.

We agree with the Appellants. We find that the Specification conveys to a person with ordinary skill in the art that the Appellants were in possession of the claimed invention. We further find that the Specification teaches a person with ordinary skill in the art how to make and use the full scope of the invention without any undue experimentation. The Examiner has failed to provide any persuasive rationale or evidence to clearly illustrate how the Specification is deficient such that the claimed invention fails to comply with the written description and enablement requirements. As such, we do not sustain the Examiner's rejection of claims 23-42 under 35 U.S.C. § 112, first paragraph.

*Claims 23-42 rejected under 35 U.S.C §102(b) as being anticipated
by Barr*

The Appellants contend that Barr fails to describe limitation [4] of claim 23 and as recited in independent claims 30 and 37. The Examiner found that Barr description of the symbol table containing the names and locations of all of the variables and functions describes limitation [4]. Ans. 13. The Examiner also found that the “wherein” clause of limitation [4] is nonfunctional descriptive material and therefore not afforded patentable weight. Ans. 11-13.

We disagree with the Examiner. Limitation [4] further limits the term “location” recited in limitations [2] and [3]. Limitation [4] specifically requires that location comprises a horizontal position and a vertical position, where the horizontal position is an upmost or lowermost position of the data unit and the vertical position is the leftmost or rightmost position of the data unit. These limitations impose a structural relationship to the input and output files and the data unit and therefore are functionally related to the remaining claim limitations.

Barr, at most, makes reference to the location of variables with the symbol table (Barr 2), but fails to specifically describe the horizontal or vertical position of a data unit. As such, we cannot sustain the Examiner’s anticipation rejection of claims 23-42.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claims 23-42 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement.

The Examiner erred in rejecting claims 23-42 under 35 U.S.C §102(b) as being anticipated by Barr.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 23-42 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement is not sustained.
- The rejection of claims 23-42 under 35 U.S.C §102(b) as being anticipated by Barr is not sustained.
- We have decided the appeal before us. However, should there be further prosecution of claims 37-40, the Examiner's attention is directed to recently issued guidance from the Director and our reviewing court, as follows below. Specifically, should there be further prosecution with respect to claims 37-40 that recite a computer program product, the Examiner's attention is directed to *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007), and *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

Appeal 2009-014145
Application 10/689,186

REVERSED

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